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EXAMINER

KRUER, KEVIN R

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY J. BLENKE,
PEIGUANG ZHOU, and THOMAS D. EHLERT

Appeal 2009-009447
Application 10/743,222
Technology Center 1700

Decided: June 25, 2010

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's
decision rejecting claims 1-10, 13, 16, 26, 79-88, 91, 94, and 104. We have
jurisdiction under 35 U.S.C. § 6.

We REVERSE.

Appellants claim an article comprising an ultrasonically bonded laminated structure which comprises a first material, a second material, and a certain adhesive composition, "wherein the first material and the second material are dissimilar materials and are ultrasonically bonded together" (claim 1).

Representative claim 1 reads as follows:

1. An article comprising an ultrasonically bonded laminated structure, the laminated structure comprising a first material, a second material, and an adhesive composition, the adhesive composition comprising an atactic polymer and an isotactic polymer, the atactic polymer having a degree of crystallinity of less than about 20% and a number-average molecular weight of from about 1,000 to about 300,000 and the isotactic polymer having a degree of crystallinity of at least about 40% and a number-average molecular weight of from about 3,000 to about 200,000, wherein the first material and the second material are dissimilar materials and are ultrasonically bonded together.

The Examiner rejects all appealed claims under 35 U.S.C. § 102 (b) as being anticipated by Zhou (US 2002/0123538, published Sep. 5, 2002).

Appellants argue that Zhou "fails to disclose a laminated structure comprising an adhesive, a first material and a second material, wherein the first and second materials are dissimilar materials that are ultrasonically bonded together" (Br. 6). Appellants explain that "dissimilar" means the materials have melting temperatures that vary by more than 40° F and have dissimilar molecular structures (*id.*), and the Examiner does not contend otherwise.

The Examiner responds to this argument as follows:

Appellant acknowledges Zhou teaches a laminate comprising "different" materials (0059) but argues Zhou fails to teach the "different" materials are "dissimilar" materials

(defined in paragraph 0023 of the specification). The examiner respectfully disagrees. Appellant's elected "dissimilar" materials are polyethylene as the "first material" and polypropylene as the "second material" (see election of 6/27/05). The laminate of Zhou may comprise polyethylene and polypropylene materials bonded together using the adhesive taught therein (See the absorbent structures incorporated by reference in paragraph 0072; specifically, US 5,176,668 (col 7, lines 24+) and US 5,904,672 (col 6, lines 9-47 and examples)). Since said laminates comprise "first" and "second" materials that are compositionally identical to Appellant's elected "first" and "second" materials, said laminates were understood to inherently met [sic] the "dissimilar" limitation of claim 1. Appellant has failed to produce any evidence demonstrating that the polypropylene and polyethylene materials taught in Zhou do not necessarily or inherently possess the characteristics of the claimed product. Since Appellant has failed to meet their burden, the examiner's position is maintained.

(Ans. para. bridging 4-5).

The Examiner's response is not well taken. As correctly explained by Appellants, the Examiner is combining separate and distinct passages in the Zhou reference, namely, the ultrasonic bonding disclosure in paragraph 67 and the materials disclosure in paragraph 72 (i.e., via incorporated references) (Br. para. bridging 11-12). According to Appellants, the Examiner cannot pick and choose separate and distinct passages from this reference so as to find each and every limitation in Appellants' claim (*id.*). We agree.

It is an established legal principle that

unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as

recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1371 (Fed. Cir. 2008).

"[D]ifferences between the prior art reference and the claimed invention, however slight, invoke the question of obviousness, not anticipation." *Id.* "Thus, it is not enough that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention." *Id.* "[T]he [prior art] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *Id.*, quoting *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972).

Here, the requirements of claim 1 are satisfied only by picking, choosing, and combining adhesive, ultrasonic bonding, and materials disclosures which are not directly related to each other by the teachings of Zhou. While this might be entirely proper under § 103, it is prohibited under § 102. The Examiner's opposing view (Ans. para. bridging 5-6) is contrary to the established legal principles discussed above.

Finally, we observe that, in responding to Appellants' argument, the Examiner questions whether the ultrasonic bonding required by claim 1 results in a different product (Ans. 5). However, the Examiner has provided no basis for the proposition that an ultrasonically bonded product is the same as a product which has not been ultrasonically bonded. On the other hand, the record contains clear evidence that such products are different since it is

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known in the art that ultrasonic bonding results in the heating, melting, and flowing of the polymeric materials into each other (Spec. para. [0005]).

Under these circumstances, we find no convincing merit in the Examiner's suggestion that claim 1 fails to distinguish from the laminate embodiments of Zhou which have not been ultrasonically bonded.

For the above stated reasons, we cannot sustain the Examiner's § 102 rejection of all appealed claims as being anticipated by Zhou.

The decision of the Examiner is reversed.

REVERSED

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